

**REMARKS**

Claims 1-3 and 5-30 are currently pending in this application. By this amendment, Claims 1, 7, 10, 11, 13, 14, 21, 25, and 30 have been amended to overcome the Examiner's objections and Claims 27-29 have been cancelled. No new matter has been added to this application by this amendment. In view of the amendments above and the remarks to follow, reconsideration and allowance of this application are respectfully requested.

In the Office Action, Claim 10 was objected to because the term "an the second sleeve" should read "and the second sleeve"; Claim 21 was objected to because the term "being being" should read "being"; Claim 25 was objected to because the word "clost" should read "close"; and Claim 30 was objected to because the term "an cover" should read "a cover". Appropriate corrections have been made to Claims 10, 21, 25 and 30.

In the Office Action, Claims 1-3 and 5-20 were rejected under 35 U.S.C. § 112, second paragraph because there was insufficient antecedent basis for the recitation "the tool assembly" in lines 7, 8 and 10 of Claim 1, thereby rendering the claim indefinite. Claims 1, 11, 13 and 14 have been amended to correct the lack of antecedent basis.

Claims 1-3 and 5-17 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,665,073 to Bulow et al. ("Bulow"). Under 35 U.S.C. § 102(b), "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. Applicants respectfully submit that Bulow fails to disclose each and every element, either expressly or inherently, recited in independent Claim 1. Claim 1, recites a surgical instrument having a body portion, a tool

assembly supported on the distal end of the body portion and an elongated cover supported about the body portion of the instrument. Claim 1 further recites, that when the elongated cover is in the first position, the distal end of the elongated cover is secured to the instrument adjacent to the tool assembly.

Bulow discloses a protective sheath 10 shown in FIG. 1, reproduced below, designed to enclose a portion of the length of monitor conduit 32, power conduit 42, and water conduit 52. Protective sheath 10 acts as a restraining device to keep each of the conduits of collective conduits 60 in a compact bundle on surgical field 20. The proximal end of protective sheath 10 is secured about monitor conduit 32, power conduit 42, and water conduit 52 by pulling drawstring 11 thereby cinching collective conduits 60. Protective sheath 10 is removed from collective conduits 60 by releasing drawstring 11 and individually uncoupling connectors 34, 44, 54 from their respective units and then pulling the respective conduit 32, 42, 52 through shield 14 and then the rest of the way through fabric sleeve 12. As shown in the FIG. 1, supported on a proximal end of monitor conduit 32 is a control unit 36 including camera probe 38, on power conduit 42 is a hand piece 46 including a probe 48, and on water conduit 52 is a hand piece 56 including a lance 58.

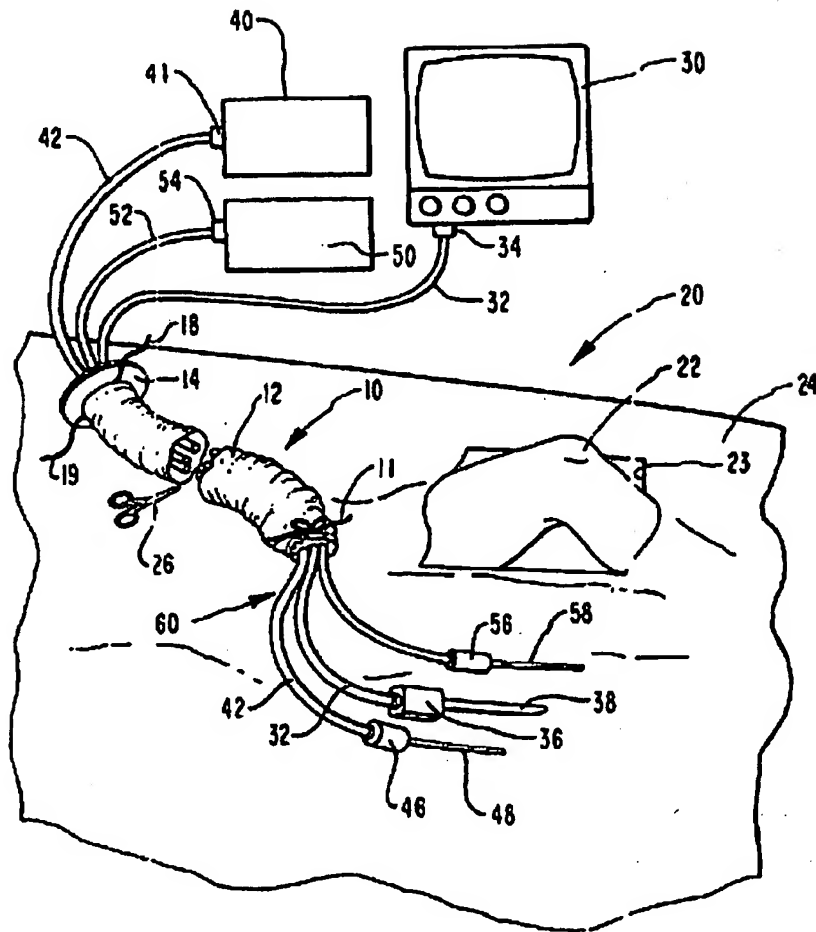


FIG. 1

Applicants respectfully submit that Bulow does not disclose each and every element recited in Claim 1. More specifically, Bulow does not disclose a surgical instrument which includes an elongated cover supported about the body portion of the instrument as recited in Claim 1. Bulow also fails to disclose an elongated cover which has a distal end, wherein "the distal end of the elongated cover is secured to the instrument adjacent to the tool assembly", as

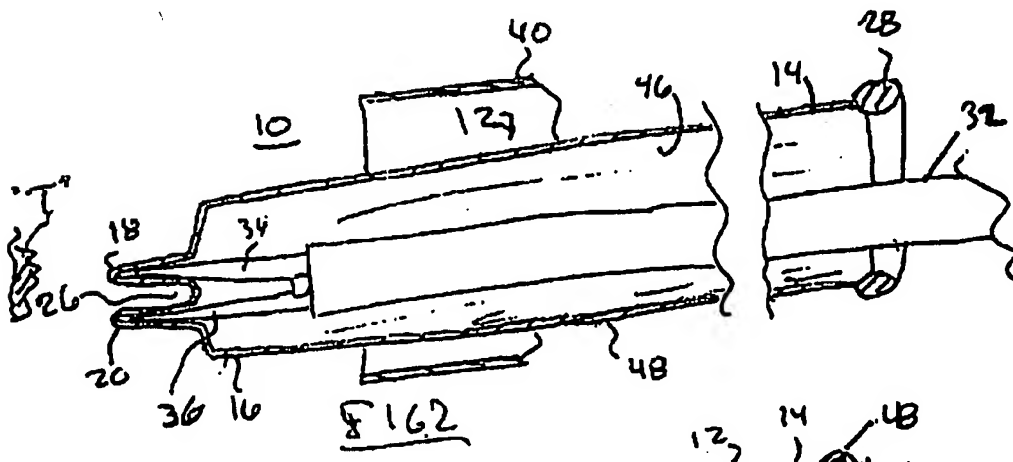
recited in Claim 1. As discussed above, Bulow discloses protective sheath 10 configured to partially encase collective conduits 60. Contrary to the Examiner's assertion, monitor conduit 32, power conduit 42 and water conduit 52 do not form body portions of the respective equipment. Instead, control unit 36, hand piece 46 and hand piece 56 correspond to the body portions of the respective instruments, and protective sheath 10 is not supported by any of control unit 36 or hand pieces 46, 56. Furthermore, as discussed above, the distal end of protective sheath is cinched about a preselected location along collective conduits 60. As noted by the Examiner, camera probe 38, probe 48 and lance 58 form the tool member of the instrument. In order to be secured adjacent probes 38, 48 and lance 58, the distal end of the protective sheath would need to cover body portions 32/36, 42,46, and 52/56. If body portions 32/36, 42,46, and 52/56 were covered by the protective sheath, the ability to manipulate tool members 38, 48, 58 would be reduced because the body portions would be bundled together. In this manner, Bulow actually teaches away from positioning the distal end of the protective sheath adjacent the tool member.

Thus, protective sheath 10 is not supported about the body portion of the instrument, nor is the distal end of the elongated cover secured to the instrument adjacent to the tool assembly when the elongated cover is in the first position, as recited in Claim 1. For these reasons, Applicants submit that Bulow does not anticipate Claim 1 and Claim 1 is in condition for allowance.

Claims 2, 3 and 5-17 depend either directly or indirectly from Claim 1. For at least the reasons discussed above with respect to Claim 1, Applicants believe that Claims 2, 3 and 5-17 are also in condition for allowance.

Claims 21, 25 and 26 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0139767 to Jespersen (“Jespersen”). Claim 21 recites, a method for performing a surgical procedure including, *inter alia*, providing a surgical instrument including a body portion, a tool assembly, and a cover, the distal end of the cover being secured about the instrument adjacent the tool assembly such that the cover is movable from a first position wherein the tool assembly is uncovered to a second position wherein the tool assembly is at least partially covered.”

Jespersen discloses an organ or tissue retrieval bag arrangement 10 shown in FIG. 2, reproduced below, including a cylindrically shaped, flexible, thin walled member or bag 12 having a first or proximal end 14 and a second or distal end 16. The distal end 16 of the retrieval bag 12 has a pair of generally tapered tubular-shaped grasper receiving tips 18 and 20 extending therefrom. Receiving tips 18 and 20 receive grasper jaws 34 and 26, respectively. Folds or pleats 30 are disposed into the sidewall of the retrieval bag 12 to provide for expansion of bag 12.



**Applicants respectfully submit that Jespersen does not disclose each and every element**

recited in Claim 21. More specifically, Jespersen does not disclose providing a surgical instrument which includes a cover, the distal end of the cover being secured about the instrument adjacent the tool assembly such that the cover is movable from a first position wherein the tool assembly is uncovered to a second position wherein the tool assembly is at least partially covered.

Although, as argued by the Examiner, the cover of Jespersen is movable from a first position wherein the tool assembly is uncovered (FIG. 5A) to a second position wherein the tool member is at least partially covered (FIG. 7), when the cover is in the first position, the cover is not "secured about the instrument adjacent the tool assembly" as required by claim 21.

Instead, as discussed above, Jespersen discloses a tissue retrieval bag arrangement 10 including a retrieval bag 12. Distal end 16 of tissue retrieval bag 12 is received about the distal end of grasper device 32. Thus, the distal end of grasper device 32 is covered when tissue retrieval bag 12 is in a first position. The distal end of grasper device 32 is not uncovered when tissue retrieval bag 12 is in a first position, as recited in claim 21. Furthermore, inversion of tissue retrieval bag 12 from a first position to a second position causes the distal end of grasper 32 to become uncovered, and does not partially cover the tool assembly as recited in claim 21. For these reasons, Applicant submits that Jespersen does not anticipate Claim 21 and Claim 21 is in condition for allowance.

Claims 25 and 26 depend either directly or indirectly from Claim 21. For at least the reasons discussed above with respect to Claim 21, Applicants believe that Claims 25 and 26 are also in condition for allowance.

Claims 27-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent

No. 5,318,221 to Green et al. ("Green"). By the present amendment, Claims 27-29 have been cancelled. Claim 30 recites a surgical instrument including, inter alia, a shell assembly having a plurality of surgical staples and an elongated cover movable from a first proximal position to a second position to cover the stationary shell assembly.

With reference to FIGS. 15A and 15B, reproduced below, Green discloses an instrument having a housing 134 and an anvil member 136. A cartridge assembly 137 is received on a relatively wider section 134B of housing 134. Cartridge assembly 137 includes a plurality of staples (not shown). A collar 127 is slidably positioned over a proximal end of housing 134 and anvil 136 to approximate the housing and the anvil towards one another.



Applicants respectfully submit that Green does not disclose each and every element recited in Claim 30. More specifically, Green does not disclose a surgical instrument including a shell assembly having a plurality of surgical staples and an elongated cover movable from a first proximal position to a second position to cover the stationary shell assembly. As discussed above, Green discloses an instrument including a housing 134 having a relatively wider distal end 134B configured to receive a cartridge assembly 137. Collar 127 is configured to slide distally to approximate anvil 136 towards housing 134, and its movement thereby advances over a proximal end of housing 134. However, as shown in FIG. 15B, collar 127 includes a diameter smaller than that of distal end 134B and anvil plate 136, thereby preventing collar 127 from covering distal



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end 134B and anvil plate 136. Therefore, collar 127 is not movable from a first position to a second position to cover the portion of housing 134 including cartridge assembly 137 (distal end 134B). For this reason, Applicant submits that Green does not anticipate Claim 30 and that Claim 30 is in condition for allowance.

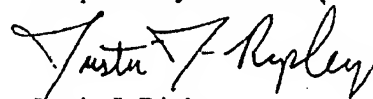
Claims 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bulow in view of U.S. Patent No. 6,024,741 to Williamson et al. ("Williamson"). Claims 18-20 depend indirectly from Claim 1. Williamson does not provide any disclosure which cures the deficiencies of Bulow with respect to Claim 1. For at least the reasons discussed above with respect to Claim 1, Applicant believes that Claims 18-20 are also in condition for allowance.

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims pending in the application, namely claims 1-3 and 5-32, are in condition for allowance. Accordingly, early and favorable reconsideration of this application is respectfully requested. Should the Examiner feel that a telephone or personal interview may facilitate resolution of any remaining matters, he is respectfully requested to contact Applicant's attorney at the number indicated below.

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